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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,878	10/04/2001	Madeleine Le	100111098-1	4404

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/971,878

**Applicant(s)**

LE ET AL.

**Examiner**

Narayanswamy Subramanian

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to applicants' communication filed on November 13, 2003 (Paper No. 9). Amendments to specification and claims 1, 3-5, cancellation of claim 10 and newly added claims 11-15 have been entered. Claims 1-9 and 11-15 are pending in the application. Claims 11-15 are subject to restriction as discussed below. Amended claims 1-9 have been examined. The response to amendments, rejections and response to arguments are stated below.

#### ***Response to Amendment***

2. Newly submitted claims 11-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The claims 1-9 that were examined in the first office action and amended claims 1-9 are drawn to a method of conducting an international transaction in goods between a buyer having a destination location for the goods and a seller of the goods having a selling location for the goods, comprising: identifying a source country for the seller's goods and a buying country for the buyer's destination for the goods; querying a shipping module to calculate a total shipping cost for shipping the goods along a shipping rout at a service level; querying a brokering module to calculate a total brokering, cost for brokering the goods along the shipping rout; querying a tax module to calculate a total tax cost for the sale and transportation of the goods; providing a total cost to the buyer, the total cost including a sale price, the total shipping cost, the total brokering cost and the total tax cost; receiving authorization to conduct the transaction; transmitting shipping instructions to a carrier; and transmitting customs invoice information to a customs broker.

Claims 11-15 are drawn to a method of conducting an international transaction in goods between a buyer having a destination location for the goods and a seller of the goods having a selling location for the goods, further comprising identifying a plurality of shipping routes and service levels to ship the goods to the destination location, the plurality of routes and service levels including the first shipping route at the first shipping route service level; wherein the step of querying the shipping module includes querying to calculate a total shipping cost for shipping the goods along each identified shipping route and service level of the plurality of shipping routes and service levels; wherein the step of querying a brokering module includes querying to calculate a total brokering cost for brokering the goods along each identified shipping route and service level of the plurality of shipping routes and service levels; wherein the step of querying a tax module includes querying to calculate a total tax cost for the sale and transportation of the goods along each identified shipping route and service level of the plurality of shipping routes and service levels; wherein the step of providing a total cost to the buyer includes providing total costs, including a sale price, the total shipping cost, the total brokering cost and the total tax cost, for shipping via one or more shipping routes and service levels of the plurality of shipping routes and service levels; and wherein the step of receiving authorization to conduct the transaction includes receiving a selection of shipping route and service level from among of the plurality of shipping routes and service levels.

Clearly the limitations of identifying a plurality of shipping routes and service levels to ship the goods to the destination location, the plurality of routes and service levels including the first shipping route at the first shipping route service level are not present in the original or amended claims 1-9. Claims 1-9 and claims 11-15 are related as sub combinations disclosed as

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usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, claims 1-9 relate to a method of conducting an international transaction in goods between a buyer having a destination location for the goods and a seller of the goods having a selling location for the goods, for a given shipping rout, whereas claims 11-15 relate to method of conducting an international transaction in goods between a buyer having a destination location for the goods and a seller of the goods having a selling location for the goods, where a shipping rout is selected from several routs using a certain criteria and then the transaction is conducted. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for amended claims 1-9 is different from that required for new claims 11-15, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented claims, these claims have been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al (US Patent 6460020 B1).

With reference to claim 1, Pool teaches a method of conducting an international transaction in goods between a buyer having a destination location for the goods and a seller of the goods having a selling location for the goods, comprising: identifying a source country for the seller's goods and a buying country for the buyer's destination for the goods (See Pool Column 7 lines 28-30 and Column 8 lines 8-10); querying a shipping module to calculate a total shipping cost for shipping the goods along a shipping rout at a service level (See Pool Column 7 lines 28-34); querying a brokering module to calculate a total brokering, cost for brokering the goods along the shipping rout (See Pool Column 11 lines 61-66 and Column 12 lines 55-58); querying a tax module to calculate a total tax cost for the sale and transportation of the goods (See Pool Column 7 lines 28-34); providing a total cost to the buyer, the total cost including a sale price, the total shipping cost, the total brokering cost and the total tax cost (See Pool Column 8 lines 45-50 and Column 12 lines 56-58); receiving authorization to conduct the transaction (See Pool Column 3 lines 49-51); transmitting shipping instructions to a carrier (See Pool Column 11 lines 53-60); and transmitting customs invoice information to a customs broker (See Pool Column 11 lines 59-65). The step of querying and the step of calculating the total brokering cost are inherent in the disclosure of Pool. The customs invoice includes copies of commercial invoice, bill of lading and export packing list and the commercial entity that specializes in moving these papers from the carrier to the customs department is the customs broker.

With reference to claim 2, Pool discloses a method of claim 1 as discussed above.

Pool does not explicitly teach the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction.

Official notice is taken that the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction is old and well known in the art. This is especially common for custom-made goods and for products that are ordered in large quantities (larger than the conventional inventory carried by the manufacturer). Such instructions help the buyer get the products made to their specification and help the manufacturer save on inventory costs.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction to the disclosure of Pool. The combination of the disclosures taken as a whole suggests that it would have helped the buyer get the products made to their specification and it would have helped the manufacturer save on inventory costs.

With reference to claim 3, Pool discloses a method of claim 1 wherein the step of transmitting the shipping instructions includes transmitting the total shipping cost calculated in the step of querying a database of shipping information to the carrier (See Pool Column 7 lines 28-34, Column 12 lines 4-7 and Column 12 lines 17-22). The step of arranging for funds to the international carrier includes the transmission of total shipping cost. When using carriers like FedEx and UPS the shipping costs are normally paid up front.

With reference to claim 4, Pool discloses a method of claim 1 wherein the step of transmitting a customs invoice information includes transmitting the total brokering cost calculated in the step of querying a database of brokering information to the broker (See Pool

Column 7 lines 5-10 and Column 12 lines 17-22). The forwarding charges are interpreted to include the total brokering cost and some other agent is interpreted to include the broker.

With reference to claim 5, Pool discloses a method of claim 1 as discussed above.

Pool does not explicitly teach the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports summarizing the received status updates in response to status requests from the buyer.

Official notice is taken that the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports in summary form in response to status requests from the buyer are old and well known in the art. These steps help the buyer keep track of the goods they are expecting to receive and take appropriate action if there are delays.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports in summary form in response to status requests from the buyer to the disclosure of Pool. The combination of the disclosures taken as a whole suggests that it would help the buyer keep track of the goods they are expecting to receive and take appropriate action if there are delays.

With reference to claim 6, Pool discloses a method of claim 1 wherein the authorization to conduct the transaction is received from the buyer after the step of providing a total cost to the buyer (See Pool Column 3 lines 46-51).

5. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al (US Patent 6460020 B1) in view of Dutta et al (US Patent 2003/0061058 A1).



With reference to claims 7-9, Pool teaches a method of claim 6 as discussed above including the step of transmitting messages to relevant legal compliance modules configured to track legal compliance information for subsequent reporting to relevant national governments (See Pool Column 10 lines 25-33)

Pool does not explicitly teach the steps of querying to identify any national restrictions that would make the transaction illegal and notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery.

Dutta discloses the steps of querying to identify any national restrictions that would make the transaction illegal (See Dutta Page 2 Paragraph 22). Official notice is taken that the steps of notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery are old and well known in the art. Notifying all parties if the transaction is identified as illegal provides a reason to the buyer as to why the transaction cannot be completed and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery protects the buyer from fraudulent sellers or sellers who may not deliver what they promised.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the steps of querying to identify any national restrictions that would make the transaction illegal and notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery to the disclosure of Pool. The combination of the disclosures taken as a whole suggests that it would help all concerned parties avoid illegal transactions and provide a reason to the buyer as to why the

transaction cannot be completed. Transmitting an authorization to bill to a billing module upon receipt of a proof of delivery protects the buyer from fraudulent sellers or sellers who may not deliver what they promised.

***Response to Arguments***

6. In reference to Applicant's arguments with respect to claim 1 that the cited art (Pool et al) fails to teach the feature of "transmitting customs invoice information to a customs broker" the Examiner disagrees. Pool (Column 11 lines 59-64) teaches that copies of bill of lading and export packing list are kept with the commercial invoice. Together these papers form a customs invoice. Pool also teaches turning over the invoices to entities that specialize in moving these papers from the carrier to the customs department. Since the invoices have the copies of bill of lading and export packing list with them, Pool teaches the feature of transmitting customs invoice information to a customs broker. The whole purpose of turning over the invoices is to have the goods cleared through customs. Hence the step of transmitting customs invoice information to a customs broker is inherent in the disclosure of Pool.

Applicant's other arguments have been considered but are not persuasive.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
January 17, 2004

 Richard Weisberger  
Primary Examiner